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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,120	08/30/2006	Takashi Akaba	062914	7744
38834 7590 06/12/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
EVANS, GEOFFREY S				
ART UNIT		PAPER NUMBER		
3742				
MAIL DATE		DELIVERY MODE		
06/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/591,120

**Applicant(s)**

AKABA ET AL.

**Examiner**

Geoffrey S. Evans

**Art Unit**

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/86)  
Paper No(s)/Mail Date 20060830
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

### DETAILED ACTION

1. The abstract of the disclosure is objected to because it is over 150 words long and includes numerous instances of the word "means", which is not permitted in the abstract because it is legal phraseology. Correction is required. See MPEP § 608.01(b).

2. Currently no double patenting rejection is required between the instant application and 10/590,902.

3. No copy of Japan Patent 58-170,177 U cited in the Information Disclosure Statement of 30 August 2006 is present in the image file wrapper. Accordingly this reference has not been considered. See 37 CFR 1.98(a)(2)(i).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4/1,6/4/1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 . Japan Patent No. 2004-130,314 discloses apparatus using a laser beam and optics for improving residual stress in a pipe. Japan Patent No. 2002-1582 discloses apparatus of a laser head (element 201) with a laser head holder portion(see figure 5) and circumferential direction moving means (elements 7,8,9,10 as shown in figure 5) for moving the laser head and the laser head holder portion along the outer periphery of the pipe. It would have been obvious to adapt Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 as a functionally equivalent way to move the laser beam along the pipe to remove residual stress. The limitations in claim 4/1 are directed to method steps and do not further limit the apparatus. Please note that in claim 4 the shape of the pipe, i.e. workpiece, also does not further limit the apparatus claims.

7. Claims 2,3,4/2,4/3,5/1,5/2,5/3,6/4/2,6/4/3,9 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 as applied to claim 1 above, and further in view of Japan Patent No. 7-9171. Japan Patent No. 7-9171 teaches adjusting orientation of the laser beam to a non-perpendicular angle which will thereby adjust the direction of the angle of the reflection of the laser light so that the laser light does not return to the laser head. It would have been obvious to adapt Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 and Japan Patent No. 7-9171 to provide this to prevent reflections of the laser beam from reaching the laser head.

8. Claim 7/4/1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 as applied to claim 4/1 above, and further in view of Pirl in U.S. Patent No. 5,491,317. Pirl teaches sending the laser beam through an optical fiber with a predetermined configuration to homogenize the laser beam. It would have been obvious to adapt Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 and Pirl to provide this to achieve uniform stress relief in the workpiece.

9. Claims 7/4/2 and 7/4/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 and Japan Patent No. 7-9171 as applied to claims 4/2 and 4/3 above, and further in view of Pirl in U.S. Patent No. 5,491,317. Pirl teaches sending the laser beam through an optical fiber with a predetermined configuration to homogenize the laser beam. It would have been obvious to adapt Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582, Japan Patent No. 7-9171 and Pirl to provide this to achieve uniform stress relief in the workpiece.

10. Claim 8/4/1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 as applied to claim 4/1 above, and further in view of Sator in U.S. Patent No. 6,476,345. Sator teaches using a plurality of laser beams from laser oscillators to send a uniform (homogenous) heating (see column 2, lines 16-17). It would have been obvious to adapt Japan Patent No. 2004-130,314 in view of Japan Patent No. 2002-1582 and Sator to provide this to uniformly relieve stresses in the workpiece.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S. Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 7:00AM to 3:30 PM (flexible).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey S Evans/

Primary Examiner, Art Unit 3742